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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08-713,905	09-13-1996	FRANK RICHTER	MO-4532 I.E.A.	2755

7590 12/19/2002

PATENT DEPARTMENT
BAYER CORPORATION
100 BAYER ROAD
PITTSBURGH, PA 152059741

EXAMINER

SERGEANT, RABON A

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 12/19/2002

24

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/713,905

Applicant(s)

Richter et al.

Examiner

Rabon Sergeant

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Sep 30, 2002
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some* c) ☐ None of:
- ☒ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|--|
| 1: Notice of References Cited (PTO-892) | 4: Interview Summary (PTO-413, Paper No. s) |
| 2: Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5: Notice of Informal Patent Application (PTO 152) |
| 3: Information Disclosure Statement(s) (PTO-1449) (Paper No(s)) | 6: Other: |

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1. Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Despite applicants' response, the position is taken that the defining of R_2 and R_3 as direct bonds, where they cannot be direct bonds, causes the claim to be confusing and indefinite.

2. Claims 1-4 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicants have failed to provide adequate support for the range of values claimed for the hydrolyzable chlorine content. The examples provide support only for 24 ppm, 34 ppm, 43 ppm, 44 ppm, and 48 ppm. The position is taken that the examples do not provide support for values below 24 ppm or above 48 ppm or for ranges of values between the specified values.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor

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and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lehmann et al. ('122) in view of Joulak et al. ('683) or Biskup et al. ('818) or Bischof et al. ('935).

Lehmann et al. disclose the production of ether isocyanates by reacting phosgene with ether amines. See column 1, lines 42+.

5. Lehmann et al. are silent regarding conducting the process in the vapor phase; however, the secondary references disclose the phosgenation of diamines in the vapor phase with an attendant increase in yield, as compared to conventional phosgenation processes. Therefore, one of ordinary skill in the art seeking a method of producing ether isocyanates and improving yield would have been motivated to utilize the vapor phase phosgenation methods of the secondary references with the ether amines of Lehmann et al., so as to obtain ether isocyanates displaying greater purity and more economical processes.

6. The examiner has considered the declaration, filed September 30, 2002; however, the declaration is deemed to be insufficient to remove the art rejection. Firstly, the declaration fails to set forth sufficient rationale as to why the disclosure within Biskup et al. that ether groups may be present within the amine should be dismissed. Secondly, in response to Biskup et al., declarer states that he would not expect production of the desired ether isocyanate in satisfactory yield from the instant process, which is not limited to a contact time of 0.5 to 5 seconds. However, this statement is not commensurate in scope with the claims, because the claims are completely silent

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with respect to any specified contact times; as a result, the instant process is open to being practiced using the 0.5 to 5 second contact time. Furthermore, the declarer fails to address the possibility that it is this disclosed contact time that permits the ether isocyanate to be produced in high yield. Therefore, in the absence of such discussion, it can be argued that this feature of Biskup et al. provides teaching as to how to obtain ether isocyanates in high yield.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (703) 308-2982.

R. Sergent
December 16, 2002


RABON SERGENT
SENIOR EXAMINER